

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

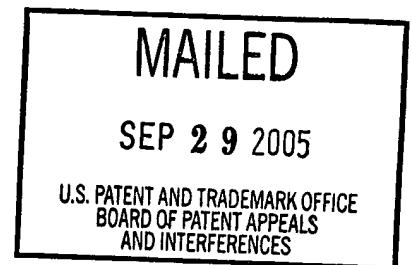
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SHIMEI FAN and TERESA JOLANTA DOWELL

Appeal No. 2005-2653
Application No. 10/001,558

ON BRIEF



Before ADAMS, MILLS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-7, 13-17, 19-22, 26 and 27. Claims 8-12 and 18 are cancelled. Claims 23-25 are withdrawn.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. An aqueous rinse-off cleansing and conditioning composition comprising:
 - a) from about 2 to about 40% by weight of an anionic surfactant;
 - b) from about 0.1 to about 20% by weight of a co-surfactant which is an ethoxylated cocomonoethanolamide with EO ranging from about 2 to about 12;
 - c) from about 0.001 to about 10% by weight of a cationic polymer;and

- d) from about 0.01 to about 30% by weight of water insoluble components with an average particle size of less than 2 μm .

The references relied upon by the examiner are:

Reid et al. (Reid) 5,085,857 Feb. 4, 1992

(Porter) Handbook of Surfactants 145-147 (Maurice R. Porter & Assoc., Chapman and Hall, N.Y. 1991)

GROUND OF REJECTION

Claims 1-7, 13-17, 19-22, 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Reid and Porter.

We affirm.

CLAIM GROUPING

Appellants did not separately group or argue any claim on appeal. Accordingly, claims 1-7, 13-17, 19-22, 26 and 27 stand or fall together. 37 CFR 41.37(c)(1)(vii). Since claims 1-7, 13-17, 19-22, 26 and 27 stand or fall together, we limit our discussion to representative independent claim 1. Claims 2-7, 13-17, 19-22, 26 and 27 stand or fall together with claim 1. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

According to the examiner (Answer, page 3), Reid teaches an aqueous shampoo composition. The examiner finds (id.), Reid's aqueous shampoo composition comprises 2-40% by weight of a surfactant which may be anionic

(e.g., sodium lauryl ether sulphate 2EO¹), nonionic (e.g., cocomonoethanolamide²), amphoteric or mixtures thereof; 0.01-3% by weight of a cationic conditioning polymer (e.g., Jaguar C13S³); and 0.01-10% by weight of an insoluble, non-volatile silicone, having an average particle size of less than 2 μm ⁴. Reid exemplifies an aqueous shampoo composition in example 4, column 6, line 57 – column 7, line 30. While the examiner recognizes that Reid does not specifically teach a particular percentage range for co-surfactants, Reid does exemplify, e.g., example 4, a composition that comprises 1.5% wt of the co-surfactant coconut monoethanolamide (cocomonoethanolamide⁵). We note that the weight percentages set forth above fall within the weight percentage ranges set forth in appellants claim 1. However, as the examiner recognizes (Answer, page 5), Reid does not teach “ethoxylated cocomonoethanolamide” as required by appellants’ claim 1.

The examiner relies on Porter to make up for the deficiency in Reid. According to the examiner (id.), Porter “teaches that the addition of ethylene oxide to alkanolamides improves dispersability or solubility in water.” We note

¹ See e.g., Reid, column 2, lines 41-46, “[t]he most preferred anionic surfactant[s] are ... sodium lauryl ether sulphate ... 2EO....” See also, example 4.

² See e.g., Reid, column 2, lines 53-56, “[o]ther suitable nonionics include ... coco mono[ethanolamide] or diethanolamide....” See also, example 4.

³ See e.g., Reid, column 3, lines 4-13 and example 4.

⁴ See e.g., Reid, column 4, lines 3-6, “[t]he average particle size of the silicone material in this emulsion and in the shampoo composition is less than 2 μm , preferably from 0.01 to 1 μm .

⁵ According to appellants (Brief, page 9), coconut monoethanolamide is otherwise known as cocomonoethanol amide or CMEA.

that Porter identifies coconut monoethanolamide + 5 EO as an example of an ethoxylated alkanolamide. Porter, page 145, section 7.7, line 11.

According to the examiner (Answer, page 5), it would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to modify the aqueous shampoo composition taught by Reid, to use ethoxylated coconut monoethanolamide instead of coconut mono-ethanolamide. According to the examiner (id.), a person of ordinary skill in the art “would have been motivated to employ ethoxylated alkanolamides in lieu of alkanolamides, i.e., ethoxylated cocomonoethanolamide in lieu of cocomonoethanolamide because ethoxylation is known to improve dispersibility, therefore resulting in a more uniform emulsion.”

In response, appellants argue (Brief, page 10), their composition “provides a significant and, given the disclosed utility of ethoxylated cocomonoethanolamide as a foaming or dispersion aid, unexpected improvement in silicone deposition.”⁶ According to appellants (Brief, page 9, emphasis removed), Reid does not disclose or suggest “that the incorporation of ethoxylated coconut monoethanolamide would provide any benefit whatsoever with respect to the deposition of the silicone conditioning agents.” In addition, appellants argue (Brief, bridging sentence, pages 9-10), “[t]here is nothing in Porter et al. that links dispersibility or solubility to particle deposition or that would motivate one skilled in the art to incorporate these materials into

⁶ Appellants rely on Examples 1-4, pages 13-17, of their specification for evidence of their unexpected results in achieving improved silicone deposition.

compositions comprising silicone ... as a means of improving silicone deposition."

On reflection, we are not persuaded by appellants' arguments regarding silicone deposition. On this record, the examiner relies on Reid to teach, and exemplify, an aqueous shampoo composition that comprises all, but one of the elements set forth in appellants' claim 1. The single difference between Reid and the composition set forth in appellants' claim 1 is that Reid teaches the use of cocomonoethanolamide instead of ethoxylated cocomonoethanolamide with EO ranging from about 2 to about 12.

As appellants recognize (Brief, page 9), Porter teaches "that the addition of ethylene oxide to monoethanolamides 'improves dispersability or solubility in water' and that foaming and wetting are 'at the optimum when 3-4 moles of ethylene oxide are added.'" Reid's shampoo composition is aqueous. Therefore, we agree with the examiner (Answer page 5) that a person of ordinary skill in the art would have found it prima facie obvious to modify the composition set forth in Reid, by substituting the cocomonoethanolamide with ethoxylated cocomono-ethanolamide to improve dispersibility resulting in a more uniform emulsion. Thus, we find appellants' composition prima facie obvious in view of the combination of Reid and Porter.

Appellants' discovery that this obvious composition has improved silicone deposition properties is insufficient to impart patentability to the composition set forth in appellants' claim 1. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("[t]he discovery of a new property or use of a previously

known composition, even when that property and use are unobvious from the prior art, cannot impart patentability to claims to the known composition”).

While there is no limitation addressing silicon deposition in the composition set forth in appellants’ claim 1, even had appellants included a phrase in claim 1 addressing the “intended use” of the composition to improve silicone deposition the result would be the same. As set forth in In re Zierden 411 F.2d 1325, 1329, 162 USPQ 102, 104 (CCPA 1969):

A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. As we said in In re Lemin, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273, 276 (1964),

Appellants are clearly correct in demanding that the subject matter as a whole must be considered under 35 U.S.C. 103. But in applying the statutory test, the differences over the prior art must be more substantial than a statement of the intended use of an old composition. ... It seems to us that the composition ... would be exactly the same whether the user were told to cure pneumonia in animals with it ... or to promote plant growth with it (as here). The directions on the label will not change the composition....

For the foregoing reasons we affirm the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over the combination of Reid and Porter. As discussed supra claims 2-7, 13-17, 19-22, 26 and 27 fall together with claim 1.

No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR § 1.136(a).

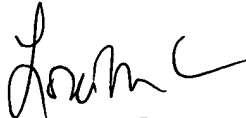
AFFIRMED



Donald E. Adams
Administrative Patent Judge



Demetra J. Mills
Administrative Patent Judge



Lora M. Green
Administrative Patent Judge

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